

REMARKS

On page 2 of the Office Action, the Examiner rejected claims 1-40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. According to the Examiner, the claims contain subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More specifically, the Examiner has asserted that it is not understood how the execution of a computer program can create all of the elements contained in figures 1A and 1B. The Examiner further asserted that it does not appear possible for a computer program to create elements such as terminal 40, analyzing unit 14, internal memory 20, and classification table analyzing unit 30.

An analysis of whether a particular claim is supported by the disclosure in a patent application requires a determination of whether the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). In *Mineral Separation*, the Court postured the question: "is the experimentation needed to practice the invention undue or unreasonable?"

Accordingly, even though 35 U.S.C. § 112 does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (holding that "the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation").

In the subject application, Applicants respectfully submit that one of ordinary skill in the art can clearly make and use the invention, without undue experimentation. For example, as the Examiner noted, the functional construction of the invention is realized by executing a computer program by a computer.

As is explained by the specification, FIGs. 1A and 1B are block diagrams showing a

functional construction of a test specification formation supporting apparatus according to the invention. Although the elements referenced by the Examiner are actual units, for example, analyzing unit 14, internal memory 20, and classification table analyzing unit 30, the functional construction of the units are realized by executing a program by a computer. In other words, the function of the units is directed according to a computer program. The specification does not state that a computer program creates the elements of Figures 1A and 1B. Rather, the specification states that the functional construction of a test specification formation supporting apparatus (which includes the various elements depicted in Figure 1A, for example) is realized by executing a program by a computer.

In light of the foregoing, Applicants respectfully submit that the claims of the present invention are enabled, as one of ordinary skill in the art would readily appreciate how to make and use the invention, without undue experimentation. Applicants respectfully submit that as the claims are in condition for allowance, no claim amendments are necessary.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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